



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,284	08/29/2005	Walter Keller	0740-70	6605
616 7590 11/27/2007 THE MAXHAM FIRM 9330 SCRANTON ROAD, SUITE 350 SAN DIEGO, CA 92121			EXAMINER NOORISTANY, SULAIMAN	
			ART UNIT 2146	PAPER NUMBER
			MAIL DATE 11/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,284	Applicant(s) KELLER, WALTER	
	Examiner Sulaiman Nooristany	Art Unit 2146	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/18/2005 & 12/08/2005</u> | 6) <input type="checkbox"/> Other: ____ |

Detailed Action

This Office Action is response to the application (10/528284) filed on 29 August 2005.

Claim Rejections. 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-20, 25-28 are rejected under 35 USC 102 (b) as being anticipated by **Fleming. US Patent No. 6,249,805.**

Regarding claim 9, Fleming teaches wherein a method to automatically handle undesired electronic mail (e-mail) in communication networks at the receiver, the method comprising:

automatically comparing the sender address accompanying an incoming e-mail to an electronically accessed list of authorized sender addresses assigned to the receiver (**Fig. 1, unit 106 – authorization component**); then

storing the e-mail in a mailbox MB of the recipient (**Fig. 2, unit 205 – store selected Email in inbox folder**), wherein the only e-mails transferred to the receiver's mailbox are those that had clearly been sent by authorized senders (**Fig. 2, unit 204 – retrieved ID in authorized list**); and

performing an analysis to see if there is serial, incremental user identification occurring so that conclusions can be drawn concerning automatic attempts at breaking into the e-mail system **(The authorization component intercepts electronic mail messages that are sent to a user before they are placed in the user's Inbox folder – Col. 4, lines 25-16; “Note, i.e.; Authorization component acts as the same as the above performance for analysis”).**

Regarding claim 10, Fleming taught the method according to claim 9, as described above. Fleming further teaches wherein there are two logically or physically, or both, separate mailboxes, said mailbox MB **(inbox folder)** and a junk mailbox JMB **(Junk Mail folder)**, wherein the e-mail server sends to the JMB mailbox all incoming e-mails that indeed have the subscriber's correct recipient address but are not contained in the sender list on the receiving side **(If the retrieved ID does not match, than the authorization component stores the intercepted electronic mail message in a pre-designated location, such as a Junk Mail folder – Col. 4, lines 24-27)**, thus making them available for further processing selectively by the internet service provider, the administrative authorities, and by the recipient **(periodically, the user can view the Junk mail folder to delete or read (means further processing) the electronic messages that we designed as junk – Col. 4, lines 34-36).**

Regarding claims 11 and 12, Fleming taught the method according to claim 9, as described above. Fleming further teaches wherein the incoming e-mails are selectively

Art Unit: 2146

put through an automatic handling and analysis process (**The authorization component intercepts electronic mail messages that are sent to a user before they are placed in the user's Inbox folder—Col. 4, lines 15-17**), which can be selectively configured by the recipient and by the ISP (**forwards the electronic mail message to the recipient via a communications mechanism such as a local area network or the Internet – Col. 1, lines 18-20**), selectively in the e-mail server, in a comparison device (**various computer systems – Col. 1, lines 35**), and in at least one of the mailboxes (**Inbox folder or Junk Mail folder**), said process initiated and configured either on a case-by-case basis or permanently (**Fig. 3**).

Regarding claims 13-16, Fleming taught the method according to claim 9, as described above. Fleming further teaches wherein all executable programs sent as attachments to e-mails are automatically separated in the JMB (**a user can indicate that all email messages received from a certain sender can automatically be stored in a designed folder (e. i.; Junk Mail folder), ... Col. 3, lines 26-28**).

Regarding claim 17 and 20, Fleming taught the method according to claim 9, as described above. Fleming further teaches wherein if an undesired e-mail is received, discontinuation requests, or cease and desist demands, can be generated automatically and delivered to the sender (**Whenever a recipient does not want to be included on a mailing list, the recipient can notify the de-spamming computer system, which will add the recipient's electronic mail address to the list of electronic mail**

addresses that are not to receive junk mail – Col. 3, lines 17-21).

Regarding claim 25-28, Fleming taught the method according to claim 9, as described above. Fleming further teaches wherein the contents of the JMB can be cyclically deleted at specific time intervals **(Periodically, the user can view the Junk Mail folder to delete or read the electronic mail messages that were designated as junk – Col. 4, lines 33-36).**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fleming**, US Patent No. **6,249,805**, in view of **Nolan** U.S. Patent App. No. US **2002/0091776**.

Regarding claim 21-24, Fleming teaches the method according to claim 9 [See rejection above] except for the claimed "*wherein virus checks of the e-mail can be carried out selectively at an established time of day or each time a message arrives.*"

Nolan teaches that it is well known to have "wherein virus checks of the e-mail can be carried out selectively at an established time of day or each time a message arrives" **(While it is accepted that email engine processors are well known, such as, those used in centralized email virus scanning [0008]).**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fleming's invention by utilizing virus system in which it solves the major problems of ensuring that the emails are handled in an efficient and timely manner in the email engine. For example, an email virus scanning program sold under the trade mark MIMESWEEPER, the systems such as MIMESWEEPER work on the gateway intercepting messages and checking them before they reach the email server (as taught by Nolan).

Response to Arguments

Applicant's arguments filed on 10/09/2007 have been fully considered but they are not persuasive. According to the applicant there is no support to find in Fleming that suggests the limitation of claim 9 "performing an analysis to see if there is serial, incremental user identification occurring so that conclusions can be drawn concerning automatic attempts at breaking into the email system."

However, Fleming teaches "performing an analysis (authorization component) to see if there is user identification occurring so that conclusions can be drawn concerning automatic attempts at breaking into the email system" (i.e.; The authorization component intercepts electronic mail messages that are sent to a user before they are placed in the user's Inbox folder, hence, authorization component acts as the same as the above process "performing an analysis" in which the system recognizes and filters out all user's based on their identity before they breaking into the email system). This means that the process of identifying of an unauthorized sender must include serial, incremental identification of user because consecutive (serial), increasing (incremental) identifying of an unauthorized user would draw to the same conclusion.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sulaiman Nooristany whose telephone number is (571) 270-1929. The examiner can normally be reached on M-F from 9 to 5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Pwu, can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

Sulaiman Nooristany 11/21/2007



JEFFREY PWU
SUPERVISORY PATENT EXAMINER